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TOWNSEND and TOWNSEND and CREW LLP

By : _____/Janet L. Newmaker/_____
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No.: 2669
John Joseph Mascavage III et al.	Examiner: Siegfried E. Chencinski
Application No.: 09/991,379	Art Unit: 3691
Filed: November 15, 2001	
For: Online Purchasing Method	**APPELLANTS' BRIEF UNDER 37 C.F.R. § 41.37**
Customer No.: 20350	

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the "Notice Of Appeal" filed May 19, 2008, for the above-referenced application, Appellants submit this Brief on Appeal.

1. Real Party In Interest

First Data Corporation of Greenwood Village, Colorado, and The Western Union Company of Englewood, Colorado, are the real parties in interest as the assignees of the above-identified application.

2. Related Appeals And Interferences

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3.   Status Of Claims

Claims 1-20 are currently pending in the application. All pending claims stand finally rejected pursuant to a final Office Action mailed March 18, 2008. The rejection of claims 1-20 is believed to be improper and is the subject of this appeal. The claims as rejected are attached as Appendix A.

Claims 1-7, 9-15 and 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,899,980 to Wilf et al. ("Wilf") in view of the cited portions of U.S. Patent No. 5,826,241 to Stein et al. ("Stein"), the cited portions of U.S. Patent Publication No. 2002/0004783 to Paltenghe et al. ("Paltenghe"), the cited portions of U.S. Patent No. 5,758,126 to Daniels et al. ("Daniels"), the cited portions of U.S. Patent No. 6,102,287 to Matyas, Jr. ("Matyas"), and Applicant Admitted Prior Art ("AAPA"). This rejection is the subject of the appeal.

Claims 8 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilf, Stein, Daniels, Matyas and AAPA in view of the cited portions of U.S. Patent No. 5,920,847 to Kolling et al. ("Kolling"). This rejection is not the subject of the appeal. Appellants do not, however, concede the rejection of these claims.

4.   Status Of Amendments

The claims have been amended three times in this case. An Amendment was filed May 25, 2006, in response to an "Order Returning Undocketed Appeal" mailed February 23, 2006. An Amendment was filed October 3, 2006, in response to a non-final Office Action mailed July 3, 2006. An Amendment was filed October 26, 2007, in response to a non-final Office Action mailed July 26, 2007. No amendments have been entered subsequent to the final Office Action mailed March 18, 2008. This Appeal Brief is filed in response to the final Office Action.

5.   Summary Of Claimed Subject Matter

In the following summary, the Appellants have provided exemplary references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. § 41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, it should be appreciated that the references are intended to be illustrative in nature only.

Claim 1 recites a method for authorizing an online purchase between a customer and a vendor site generally depicted in Fig. 11. The method includes, at a funds transaction server (230), receiving transaction information from the vendor site (201, ¶[54]), wherein the transaction information comprises a transaction amount (¶[54]); opening a pop-up window for the customer (908, Fig. 9); from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount (¶¶[86]-[88]); receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase (¶[97]); and notifying the vendor site of authorization (1232, Fig. 12).

Claim 10 recites a method for checking-out from an online purchase by a customer from a merchant system generally depicted at Fig. 11. The method includes at a funds transfer system (230), receiving transaction information from the merchant system (201, ¶[54]), wherein the transaction information includes a transaction amount (¶[54]) and wherein the funds transfer system is located at a network location away from the merchant system (Fig. 1A); opening a pop-up window that is viewable by the customer, wherein the pop-up window is formulated by the funds transfer system (908, Fig. 9); from the funds transfer system, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount (¶¶[86]-[88]); receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase (¶[97]); and notifying the merchant system of authorization (1232, Fig. 12).

Claim 17 recites a method for checking-out from an online purchase by a customer from a merchant system depicted generally at Fig. 11. The method includes, at a funds transfer system (230) that is located at a network location away from the merchant system (Fig. 1A), receiving account information from the customer corresponding to an account available for debits by the funds transfer system (1136, 1140); opening a pop-up window that is viewable by the customer, wherein the pop-up window is formulated by the funds transfer system (908, Fig. 9); from the funds transfer system, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount (¶¶[86]-[88]); receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase (¶[97]); and notifying the merchant system of authorization (1232, Fig. 12).

Claim 12 depends from claim 10, discussed above. In addition to the elements of claim 10, claim 12 recites "wherein the pop-up window overlays an existing web browser window of a web site associated with the merchant system," as illustrated in Fig. 9 and discussed at ¶¶[79]-[80].

Claim 13 depends from claim 10, discussed above. In addition to the elements of claim 10, claim 13 recites "wherein the receiving transaction information step triggers the opening a pop-up window step," as shown in Fig. 11 and described at ¶¶[83]-[88].

6.   Grounds Of Rejection To Be Reviewed On Appeal

Issue 1: Whether claims 1-7, 9-15 and 17-20 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,899,980 to Wilf et al. ("Wilf") in view of the cited portions of U.S. Patent No. 5,826,241 to Stein et al. ("Stein"), the cited portions of U.S. Patent Publication No. 2002/0004783 to Paltenghe et al. ("Paltenghe"), the cited portions of U.S. Patent No. 5,758,126 to Daniels et al. ("Daniels"), the cited portions of U.S. Patent No. 6,102,287 to Matyas, Jr. ("Matyas"), and Applicant Admitted Prior Art ("AAPA").

7. **Argument**

Issue 1: Whether claims 1-7, 9-15 and 17-20 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,899,980 to Wilf et al. ("Wilf") in view of the cited portions of U.S. Patent No. 5,826,241 to Stein et al. ("Stein"), the cited portions of U.S. Patent Publication No. 2002/0004783 to Paltenghe et al. ("Paltenghe"), the cited portions of U.S. Patent No. 5,758,126 to Daniels et al. ("Daniels"), the cited portions of U.S. Patent No. 6,102,287 to Matyas, Jr. ("Matyas"), and Applicant Admitted Prior Art ("AAPA").

The Appellants maintain that the rejection of claims 1, 10 and 17 under 35 U.S.C. § 103(a) is improper because the record has not established a *prima facie* case of obviousness. Specifically, the record has not properly followed the Graham factors to arrive at a showing that all claim elements exist in the prior art and has not established the relevant skill necessary to determine that it would have been obvious to combine the references. Moreover, there is no "clear articulation of the reasons(s) why the claimed invention would have been obvious," the "key to supporting any rejection under 35 U.S.C. 103," according to MPEP 2141.

Herein, the Appellants specifically discuss the differences between the prior art and the claimed invention. Based on these differences, the failure of the record to address the level of skill of one in the relevant art, and the absence of the necessary "clear articulation" of the reasoning behind the rejections, the Appellants urge that the case be moved to allowance.

Claim 1 recites:

1.   A method for authorizing an online purchase between a customer and a vendor site, the method comprising steps of:

at a funds transaction server, receiving transaction information from the vendor site, wherein the transaction information comprises a transaction amount;

opening a pop-up window for the customer;

>   from the funds transfer sever, interacting with the pop-up window
>   to present a transaction amount in the pop-up window and receiving
>   customer assent to the transaction amount;
>
>   receiving authorization from the customer of a debit for the
>   transaction amount, wherein the debit corresponds to the online purchase;
>   and
>
>   notifying the vendor site of authorization.

The Appellants direct attention to the element "from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount." Claims 10 and 17 include a similar element. The cited references do not teach or suggest this. The record cites Stein for this teaching, but Stein does not teach or suggest a funds transfer server interacting with a pop-up window to present a transaction amount and receive a customer's assent to the transaction amount. The final Office Action of March 18, 2008, appears to assert that Stein's teaching of presenting a transfer amount through an Internet interface is the same as "interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount." It states at page 3 that "the ordinary practitioner of the art would have seen it as obvious at the time of the Appellants' invention that a web browser window was a practical and popular interface for displaying this transaction data for the customer buyer's authorization or rejection of the payment by transfer." This is tantamount to an admission that Stein does not teach or suggest the element, and the Office Action fails to cite another reference for this teaching. Specifically, neither Daniels nor Matyas teach or suggest this element. Moreover, while the Appellants remain unable to understand the Office Action's reasoning regarding the alleged AAPA, even the supposed AAPA fails to teach or suggest "interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount." Hence, claims 1, 10 and 17 are believed to be allowable, at least for this reason.

The record has not identified the level of skill in the relevant art. Instead, the record relies on a motivation test to justify the combination of references used to reject the independent claims. The rejections are, therefore, deficient, since the motivation test is predicated on the prior art including all the claim elements, which it does not, as discussed above. Hence, in the absence of the relevant skill being identified and there being no clear articulation of the reasoning that would motivate the skilled artisan to supply the missing limitations, the rejections are improper.

Moreover, even if the reference are shown to include all claim elements, which they do not, the motivation would, nevertheless, fall short of that which is necessary to justify the rejections. The final Office Action of March 18, 2008, cites a single motivation, suggesting that this motivation is sufficient grounds for combining all six references. It is not. Stein, for example, directly contradicts the motivation "to overcome the reluctance of some users to transmit credit card information over the internet," because Stein teaches doing just that. In other words, if the motivation is correct, the skilled partisan would look no further than the Stein reference itself to satisfy the motivation. No other reference would be needed. A proper motivation must have some logical connection to the combination, otherwise, it is not a "motivation to combine." Moreover, expanding the group of references results in similar flaws based on this motivation. Hence, claims 1, 10 and 17 are believed to be allowable, at least for this additional reason.

The remaining claims depend from one of the independent claims discussed above and are believed to be allowable, at least for the reasons stated above. Moreover, claims 12 and 13 are believed to be allowable because the final Office Action states that the limitations are "implicit," which they are not. Claim 12 recites "wherein the pop-up window overlays an existing web browser window of a web site associated with the merchant system," but all pop-up windows *do not* necessarily overlay an existing web browser window. The existing window may not occupy the entire screen, in which case, the pop-up may overlay a portion of the screen not occupied by the existing window. Further, some pop-up windows may position themselves behind an existing window, becoming visible only after the user closes the existing window. Hence, this element is neither "implicit" nor "explicit."

Likewise, regarding claim 13, not all pop-ups are triggered by receiving transaction information as recited in the claim. Pop-ups may be triggered by any of a number of events other than receiving transaction information. Hence, the limitation of claim 13 is not necessarily present in the cited references, and claims 12 and 13 are believed to be allowable for this additional reason.

8.   Conclusion

For these reasons, it is respectfully submitted that the rejections should be reversed.

Respectfully submitted,

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9.   Claims Appendix

1.   (Previously Presented) A method for authorizing an online purchase between a customer and a vendor site, the method comprising steps of:

at a funds transaction server, receiving transaction information from the vendor site, wherein the transaction information comprises a transaction amount;

opening a pop-up window for the customer;

from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount;

receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and

notifying the vendor site of authorization.

2.   (Previously Presented) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, wherein the pop-up window points away from the vendor site.

3.   (Original) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, further comprising a step of receiving account information from the customer corresponding to an account authorized for the debit.

4.   (Previously Presented) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, wherein the pop-up window overlays an existing web browser window of the vendor site.

5.   (Previously Presented) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, wherein the receiving transaction information step triggers the opening a pop-up window step.

6.   (Original) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, further comprising a step of transferring payment to an account associated with the vendor site after authorization is received.

7.   (Previously Presented) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, further comprising a step of presenting a message to the customer in the pop-up window indicating at least one of the following:

that authorization was canceled by the customer;

that authorization was rejected by a funds transfer system; and

that authorization completed normally.

8.   (Original) The method for authorizing the online purchase between the customer and the vendor site as recited in claim 1, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period.

9.   (Original) A computer-readable medium having computer-executable instructions for performing the computer-implementable method for authorizing the online purchase between the customer and the vendor site of claim 1.

10.   (Previously Presented) A method for checking-out from an online purchase by a customer from a merchant system, the method comprising steps of:

at a funds transfer system, receiving transaction information from the merchant system, wherein the transaction information includes a transaction amount and wherein the funds transfer system is located at a network location away from the merchant system;

opening a pop-up window that is viewable by the customer, wherein the pop-up window is formulated by the funds transfer system;

from the funds transfer system, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount; receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and

notifying the merchant system of authorization.

11.   (Original) The method for checking-out from the online purchase by the customer from the merchant as recited in claim 10, further comprising a step of receiving account information from the customer corresponding to an account available for debits by the funds transfer system.

12.   (Previously Presented) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 10, wherein the pop-up window overlays an existing web browser window of a web site associated with the merchant system.

13.   (Previously Presented) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 10, wherein the receiving transaction information step triggers the opening a pop-up window step.

14.   (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 10, further comprising a step of transferring payment to an account associated with the merchant system after authorization is received.

15.   (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 10, further comprising a step of presenting a message to the customer in another window indicating at least one of the following:

        that authorization was canceled by the customer;

        that authorization was rejected by the funds transfer system; and

        that authorization completed normally.

16.   (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 10, wherein the notifying step comprises a step of determining that a notification message was not received by the merchant system within a predetermined time period.

17.   (Previously Presented) A method for checking-out from an online purchase by a customer from a merchant system, the method comprising steps of:

at a funds transfer system that is located at a network location away from the merchant system, receiving account information from the customer corresponding to an account available for debits by the funds transfer system;

opening a pop-up window that is viewable by the customer, wherein the pop-up window is formulated by the funds transfer system;

from the funds transfer system, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount; receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase; and

notifying the merchant system of authorization.

18.   (Previously Presented) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 17, wherein the account information is received through the pop-up window.

19.   (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 17, further comprising a step of receiving transaction information from the merchant system.

20.   (Original) The method for checking-out from the online purchase by the customer from the merchant system as recited in claim 17, further comprising a step of transferring payment to an account associated with the merchant system after authorization is received.

10.   Evidence Appendix

No additional evidence is provided.

11.   Related Proceedings Appendix

No additional proceedings are in process.